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R E M A R K S

Reconsideration of the present application in view of the amendments and following remarks is respectfully requested. Claims 1 through 26 have been canceled without prejudice or disclaimer. Sixteen claims are pending in the application: Claims 27 through 42.

Objections to the Claims

1. Claims 4 and 16 stand objected to as containing typographical errors.

Claims 4 and 16 have been canceled without prejudice or disclaimer, thus the objects are overcome.

35 U.S.C. § 102

2. Claims 1, 6-8, 18 and 22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,353,391 (Cohen et al.).

Claims 1, 6-8, 18 and 22 have been canceled without prejudice or disclaimer, thus the rejection is overcome.

3. Claims 27-32 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,504,545 (Browne et al.). Further, claims 33-35, 37-42 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,411,338 (Neill).

Applicant notes that both Browne et al. and Neill were not published more than one year before the filing date of the present application, thus, a Browne et al. and Neill are cited under 35 U.S.C. 102(e).

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In order to remove the *Browne et al.* and *Neill* references cited for the rejection of claims 27-35 and 37-42 under 35 U.S.C. 102(e) Applicant submits evidence establishing a reduction to practice of the claimed invention prior to the filing dates of *Browne et al.* and *Neill*, i.e., prior to March 29, 1999 and January 25, 2000, respectively; thus, overcoming a rejection under 35 U.S.C. 102(e) by establishing the invention of Applicant's claimed invention prior to the filing dates of the *Browne et al.* and *Neill* patents. As the filing date of *Browne et al.* (i.e., March 29, 1999) is the earlier of the two filing dates, the rejection will be addressed herein in relation to the March 29, 1999 date. The evidence establishing a prior reduction to practice is submitted in the form of the following declaration under 37 C.F.R. 1.131: (a) the Declaration of Maurice F. Rabb, III (hereinafter referred to as the "Rabb declaration"). Per MPEP 715.07, the dates have been blocked out of the exhibits attached to the Rabb declaration; however, all dates are prior to March 29, 1999.¹

When any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the filing date of the reference on which the rejection is based.² The declaration under 37 C.F.R. 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it.³ Proof of a reduction to practice of the invention prior to the filing date

¹ Rabb Declaration, paragraph 4

² 37 CFR § 1.131(a) and MPEP 715

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of the reference is sufficient to overcome a rejection based upon the reference.⁴ Generally, *proof of an actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.*⁵

As established in the Rabb declaration, software that implements the display of images and image transitions was used prior to March 29, 1999. Thus, the software that implements the display of images and image transitions as shown in Exhibit A is an implementation of a method falling within claims 27-42, i.e., claims 27-42 read upon the software implementation.

Therefore, given the Rabb declaration and Exhibit A, it is respectfully submitted that a method covered under claims 27-42 existed prior to March 29, 1999 and that it would work for its intended purpose.⁶

Thus, as required under MPEP 715.07, it is submitted that a software implementation that includes all of the limitations specified in claims 27-42 existed prior to March 29, 1999 and that the inventor recognized that the software implementation worked for its intended purpose prior to March 29, 1999. Thus, by establishing the invention of Applicant's claimed invention prior to the filing dates of the Browne et al. and Neill patents the rejection under 35 U.S.C. § 102(e) is overcome.

Thus, Applicant respectfully submits that the rejection of claims 27-35 and 37-42 is overcome.

3 In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) and MPEP 715.02

4 37 CFR 1.131(b) and MPEP 715.07

5 MPEP 715.07

6 Rabb Declaration Paragraph 7

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35 U.S.C. § 103

4. Claims 2, 10-16, 20, 21, 23-25 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,353,391 (Cohen et al.) in view of U.S. Patent No. 6,411,338 (Neill).

Claims 2, 10-16, 20, 21, and 23-25 have been canceled without prejudice or disclaimer, thus the rejection is overcome.

Regarding claim 36, as outlined above, Neill can not properly be cited as a reference under 35 U.S.C. 102(e)/103(a) because Applicant has submitted evidence establishing a reduction to practice of the claimed invention prior to the filing date of Neill. Thus, Applicant respectfully submits the rejection of claim 36 is overcome.

5. Claims 3-5 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,353,391 (Cohen et al.) in view of U.S. Patent No. 6,057,833 (Heidmann et al.).

Claims 3-5 and 9 have been canceled without prejudice or disclaimer, thus the rejection is overcome.

6. Claims 17, 19 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,353,391 (Cohen et al.) in view of U.S. Patent No. 6,411,338 (Neill) and further in view of U.S. Patent No. 6,504,545 (Browne et al.).

Claims 17, 19 and 26 have been canceled without prejudice or disclaimer, thus the rejection is overcome.

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C O N C L U S I O N

In view of the above, Applicant submits that the pending claims are in condition for allowance, and prompt and favorable action is earnestly solicited. Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas F. Lebens at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



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Dated: August 3, 2004

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Attachments: Declaration of Maurice F. Rabb, III.
Exhibit A